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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,973	01/16/2004	James Stoffer	423.021US1	6511

21186 7590 04/04/2007
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EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/758,973

Applicant(s)

STOFFER ET AL.

Examiner

Michael J. Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-28,30-56,59-61,63-104,112,113,115-120 and 123-150 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,14,16-20,28,63,67-71,92,95,96,99,100,102,113,125-127,134,139,141 and 147 is/are rejected.
- 7) ☒ Claim(s) See Continuation Sheet is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 2,9-13,15,21-23,30-37,42-44,50,51,59,64,73,82,88,93,94,97,98,112,118 and 128-130.

Continuation of Disposition of Claims: Claims objected to are 3-6,24-27,38-41,45-49,52-56,60,61,65,66,72,74-81,83-87,89-91,101,103,104,115-117,119,120,123,124,131-133,135-138,140,142-146 and 148-150.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :20040528,20040730,20050316,20060330,20061219.

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DETAILED ACTION

Pending Claims

Claims 1-6, 9-28, 30-56, 59-61, 63-104, 112, 113, 115-120, and 123-150 are pending.

Of these, claims 2, 9-13, 15, 21-23, 30-37, 42-44, 50, 51, 59, 64, 73, 82, 88, 93, 94, 97, 98, 112,

118, and 128-130 are withdrawn from consideration.

Election/Restrictions

1. Applicant's election without traverse in the reply filed on December 19, 2006 is acknowledged.

2. Claims 2, 9-13, 15, 21-23, 30-37, 42-44, 50, 51, 59, 64, 73, 82, 88, 93, 94, 97, 98, 112, 118, and 128-130 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 19, 2006.

Claim Objections

3. Claim 120 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 120 is dependent from cancelled claim 57.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 14, 16-20, 28, 63, 67-71, 92, 95, 96, 99, 102, 113, 125-127, 134, 139, and 141 rejected under 35 U.S.C. 102(b) as being anticipated by Murase et al. (JP 01-319574).

Regarding claims 1, 14, 16-20, 28, 92, 95, 113, 125-127, and 139, Murase et al. disclose:

(1) a coating composition comprising one or more corrosion-inhibiting carbon pigments in an effective corrosion-inhibiting amount and one or more binders (Abstract);

(14) wherein at least one of the one or more corrosion-inhibiting carbon pigments is an amorphous form of carbon (Abstract);

(16) wherein the one or more corrosion-inhibiting carbon pigments are present in the composition in a weight percent range of between about 0.1 to about 100% of total pigment concentration (Abstract);

(17) wherein the coating composition has a pigment volume concentration of between about 5 to about 55 (Abstract);

(18) wherein at least one of the one or more binders is an organic binder (Abstract);

(19) wherein at least one of the one or more binders is an epoxy-based resin binder (Abstract); (20) wherein the epoxy-based resin binder is an amine-cured epoxy-based resin binder (Abstract);

(28) further comprising one or more corrosion co-inhibitors (Abstract);

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(92) a method of preparing a coating composition according to claim 1, the method comprising: preparing a mill base having one or more binders; and adding an effective corrosion-inhibiting amount of a one or more corrosion-inhibiting carbon pigments to the mill base to produce the coating composition (Abstract); (95) wherein the method further comprises adding to the mill base one or more materials selected from the group consisting of a neutral to slightly acidic generating extender, an acidic generating extender, one or more rare earth compounds, one or more *additives*, and combinations thereof (Abstract);

(113) wherein the corrosion-inhibiting carbon pigments are present in the composition in a weight percent range of between about 3% to about 25% of total pigment concentration (Abstract);

(125) wherein the corrosion-inhibiting carbon pigment is present in the composition in a weight percent of at least about 6% of total pigment concentration (Abstract);

(126) wherein the effective corrosion-inhibiting amount of the one or more corrosion-inhibiting carbon pigments is an amount which provides the coating composition with at least a 2, 4 A rating on the Keller Corrosion Rating Scale for a 500 hour salt fog test, as tested according to ASTM B117 procedure (*inherently satisfied because material limitations are satisfied – see MPEP 2112.01*);

(127) wherein the effective corrosion-inhibiting amount of the corrosion-inhibiting carbon pigment is at least about 6 wt%, and the coating composition has at least a 2, 4 A rating on the Keller Corrosion Rating Scale for a 500 hour salt fog test, as tested according to ASTM B 117 procedure (*inherently satisfied because material limitations are satisfied – see MPEP 2112.01*); and

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(139) a method of preparing a coating composition according to claim 1, the method comprising: preparing a dispersion of one or more binders; incorporating one or more corrosion-inhibiting carbon pigments into the one or more binders to form a base composition; and incorporating an activator into the base composition (Abstract).

Regarding claims 63, 67-71, 134, and 141, Murase et al. disclose: (63) A coating system comprising: a coating composition according to claim 1 applied to a substrate (Abstract);

(67) wherein at least one of the one or more binders is a resin binder (Abstract); (134) wherein the resin binder is an epoxy-based resin binder (Abstract);

(68) wherein the coating composition is cured naturally or with an accelerated method of curing which exposes the coating composition to heat, UV energy, microwave energy, or combinations thereof (Abstract);

(69) wherein the substrate is coated by a method of application selected from the group consisting of spraying, brushing, rolling and dipping (Abstract);

(70) wherein the substrate is a composite substrate (Abstract).

(71) wherein the substrate is selected from the group consisting of aluminum, aluminum alloys, steel, galvanized steel, zinc, zinc alloys, magnesium, and magnesium alloys (Abstract); and

(141) wherein the system is a water-borne system, a solvent-borne system, a powder system or an appliqué system (Abstract).

Regarding claims 96, 99, and 102, Murase et al. disclose: (96) A method comprising: providing a substrate to be coated (Abstract); and coating the substrate with a coating composition according to claim 1 (Abstract);

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(99) wherein the coating composition further contains a material selected from the group consisting of one or more extenders selected from the group consisting of a neutral to slightly acidic generating extender, an acidic generating extender, and combinations thereof, one or more rare earth compounds, one or more *additives* and combinations thereof (Abstract); and

(102) wherein the substrate is a composite substrate (Abstract).

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 100 and 147 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murase et al. (JP 01-319574).

Regarding claims 100 and 147, these claims are product-by-process, wherein the pretreatment of claim 100 is open to (*non-chemical*) procedures such as washing. In light of this, it has been found that, “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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Therefore, regardless of the non-chemical pre-treatment and method of coating, it appears that the coated substrate of Murase et al. would have inherently or obviously satisfied the instantly claimed coated substrate.

Allowable Subject Matter

8. Claims 3, 4, 5, 6, 49, 65, 72, 81, 87, 101, 103, 124, 140, and 145 (*and all claimed dependent from these claims*) are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

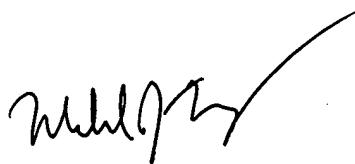
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Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael J. Feely
Primary Examiner
Art Unit 1712

April 2, 2007

MICHAEL FEELY
PRIMARY EXAMINER